

REMARKS

Claims 1 and 39 are amended. No new subject matter is added. Claims 1-55 remain pending. Entry of the amendments and reconsideration of the pending claims is respectfully requested in light of the following remarks.

Claim Objections

Claims 39-46 were objected to and, in particular, claim 39 was objected to because it recites “colored pattern” rather than “a colored pattern.” To cure this informality, claim 39 is amended to recite “a colored pattern,” thereby removing the objection. It is requested that the amendment to claim 39 be entered because it adopts examiner suggestions, removes issues for appeal, or in some other way requires only cursory review by the examiner. MPEP 714.13(II).

Claim Rejections - 35 U.S.C. § 112

Claims 1-17 were rejected under 35 U.S.C. § 112, first paragraph, because the Examiner states that the specification, while being enabling for “an automatic document feeder *included* in an optical scanner,” allegedly does not reasonably provide enablement for “an automatic document feeder *including* an optical scanner.” While not addressing whether or not the rejection is proper, in order to advance prosecution claim 1 is amended to recite “an automatic document feeder included in an optical scanner” rather than “an automatic document feeder including an optical scanner.” It is requested that the amendment to claim 1 be entered because it adopts examiner suggestions, removes issues for appeal, or in some other way requires only cursory review by the examiner.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 3, 11-14, 17-19, 30-33, 35-39 and 50-55 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,124,810 to Seto (“Seto”). The applicant respectfully disagrees.

Claim 1 recites “capturing a first image of the document while the document is in said first position,” “feeding the document an appropriate length to a second position,” and “capturing a second image of the document while said document is in said second position.” Claim 1 further

recites that “the appropriate length comprises a length that is less than a total length of the document.”

The Examiner states at page 3 of the office action, that Seto’s “document is fed by the total length of the document to a second position.” He further argues that the total length of Seto’s document that is fed meets the claimed appropriate length. The justification for this is that “the total length of the document inherently comprises any length that is less than a total length of the document.”

While the supposition that “the total length of the document inherently comprises any length that is less than a total length of the document” is undoubtedly a tautology, the applicants would respectfully point out that the office action’s argument hinges *on the interpretation* that Seto’s total document length reads upon both “the appropriate length” and “a total length of the document” as recited in claim 1.

This is not the appropriate interpretation. In fact, because the applicant used two different terms within the same clause of the claim, e.g., “appropriate length” and “total length,” it should be inferred that a different meaning should be assigned to each. See Ethicon Endo-Surgery, Inc., v. U.S. Surgical Corp., 93 F.2d 1572, 1579 (Fed. Cir. 1996), stating that if two terms described a single element, ‘one would expect the claim to consistently refer to this element [with one or the other of the two terms], but not both, especially within the same clause’. See also Bancorp Servs., L.L.C. v. Hartford Life Ins. Co., 359 F.3d 1367, 1373 (Fed. Cir. 2004), “[t]he use of [two] terms in close proximity in the same claim gives rise to an inference that a different meaning should be assigned to each.”

According to claim 1, the appropriate length is not just any length included in the total length, it is the length that the document is fed from a first position where a first image is captured to a second position where a second image is captured. Seto fails to disclose feeding a document an appropriate length that is different from the total length of the document. For at least this reason, Seto fails to anticipate claim 1 because it does not show the identical invention in as complete detail as contained in the claim. MPEP 2131. Claims 3, 11-14 and 17 are not anticipated by Seto at least because they inherently contain the features of claim 1.

Claims 18 and 38 recite features that are similar to claim 1, and were rejected using the same rationale as claim 1. Thus, Seto also fails to anticipate claims 18 and 38 for at least the

same reason that was outlined above for claim 1. Claims 19, 30-33, 35-39, and 50-55 are not anticipated by Seto at least because they inherently contain the features of claim 18.

Claim Rejections – 35 U.S.C. § 103

Claims 2, 20-24 and 40-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Seto in view of U.S. Patent No. 6,064,778 to Pasco et al. ("Pasco"). Claims 4-6, 15, 16 and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Seto. Claims 25-29 and 45-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Seto in view of Pasco et al. as applied to claims 23, 18, 44 and 38, and further in view of well known prior art.

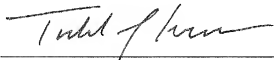
The applicant respectfully disagrees. Claims 2, 4-6, 15, 16, 20-29, 34, and 40-49 are allowable over Seto, the combination of Seto and Pasco, or the combination of Seto, Pasco, and well known prior art at least because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of all pending claims is requested. Please telephone the undersigned at 503-222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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